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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,877

Applicant(s)

WAJS, ANDREW AUGUSTINE

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/08/03 (Amendment) .
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

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DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on April 8, 2003. In the amendment,
5 claims 1, 6, and 8 were amended. Currently, claims 1-8 remain for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

10 A person shall be entitled to a patent unless –

15 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Rohrbach
(US 5,898,783).

20 Re claims 1, 4, 6, and 8, Rohrbach teaches a security system for checking authorization
(col. 1, lines 14-28) comprising a number of secure devices 110 in the form of smart cards,
which in turn, includes data communication circuitry 200, logic circuitry 210 and disabling
circuitry 220 (col. 4, lines 4+). The card, used in tandem with a mobile station 100 transmits a
code uniquely identifying the card for authorization and authentication purposes (col. 3, lines
25 66+; col. 4, lines 13+). The processes of retrieving and transmitting identification number,
receiving response (i.e., signal to disable the card), and responding according to the received

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signal from the host constitute an algorithm. Furthermore, since the card contains SIMs (subscriber identity module) as part of a chip (col. 1, lines 29+), each card is provided with a unique chip layout for performing the same function – algorithm for authentication and authorization.

5 Re claims 2, 3, and 7, SIM is a use of non-volatile memory, and other memory components such as FPGA, PAL and ASIC (col. 5, lines 32+). Although Rohrbach does not explicitly states use of volatile memory, smart card contains RAM to retrieve and process information from non-volatile memory and/or the host machine.

10

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

15

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbach (US 5,898,783) in view of Tanaka (US 4,924,075, previously cited). The teachings of Rohrbach have been discussed above.

Rohrbach fails to specifically teach or fairly suggest that FPGA in IC card is stored in battery-powered RAM.

25 Tanaka teaches a smart card 1 powered by internal battery 6 (col. 1, line 67 – col.2, line 10).

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In view of Tanaka's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further incorporate a well-known internal battery to the teachings of Rohrbach in order to make the card versatile. By powering the card with internal battery, the card can be used with external device, which does not carry power supply.

5 Moreover, significant data can be stored in the memory section being powered by the internal battery. Accordingly, such modification would have been an obvious extension as taught by Tanaka to provide self-supplying power source to internal memory, and therefore an obvious expedient.

10 4. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbach (US 5,898,783) in view of Cantone et al. (US 5,594,657, previously cited). The teachings of Rohrbach have been discussed above.

Rohrbach fails to specifically teach or fairly suggest of synthesizing, layout and use of high-level language as a method of programming FPGA.

15 Cantone teaches that FPGA can be programmed utilizing synthesis (col. 1, line 62 – col. 2, line 7) and layout tool (col. 16, lines 7 – 18). Cantone further teaches of programming FPGA with user-friendly graphics interface (high level language), and the program is compiled to produce efficient executable (Abstract).

In view of Cantone's teaching, it would have been obvious to an ordinary skill in the art
20 at the time the invention was made to employ a well-known method of FPGA programming to the teachings of Rohrbach in order to make the programming easier to the users. Furthermore, by compiling/optimizing the source code, the executable program is compact in size requiring

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less memory space to load the programs. Optimized executable program tend to run faster, and the executable code can be ported to other FPGA, and thus an obvious expedient.

Response to Arguments

- 5 5. In the amendment filed on April 8, 2003, the Applicant traversed the rejection by amending claims 1, 6, and 8. Accordingly, the newly amended elements required additional search and consideration.

Applicant's arguments with respect to the amended claims further clarifying the claims have been considered but are moot in view of the new ground(s) of rejection.

10

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

- 15 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37
- 20 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Bialick et al. (US 6,003,135) disclose security system comprising FPGA circuitry in smart cards.

- 5 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

15 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

20 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

25

Ahshik Kim
Patent Examiner
Art Unit 2876
30 June 17, 2003

DANIEL St. Cyr
PRIMARY EXAMINER

